

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent of: Christopher de Voir, et al. Issued: September 29, 2009
Patent Number: 7,596,535 Art Unit: 2129
Filed: September 29, 2003 Examiner: Nathan H. Brown, Jr.
For: APPARATUS FOR THE CLASSIFICATION OF PHYSIOLOGICAL EVENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
37 C.F.R. § 1.705(d)

1. This request is for reconsideration of the patent term adjustment indicated on page 3 of the Notice of Allowance dated May 13, 2009.
2. Applicant submits herewith a "Statement of the Facts involved in Determining the Patent Term Adjustment" 37 C.F.R. § 1.705(b)(2).
3. This patent is not subject to a terminal disclaimer. 37 C.F.R. § 1.705(b)(2)(iii).

4. The fee set forth in § 1.18(e) (\$200.00), required by 37 C.F.R. § 1.705(b)(1), was previously submitted with the Request for Reconsideration of Patent Term Adjustment Under 37 C.F.R. § 1.705(b), filed June 19, 2009 and dismissed a premature by the Office of Petitions on August 31, 2009. A copy of the Office of Petitions' decision is attached to this paper. Applicant believes no new fees are due.

If Applicant is in error, please charge any fees required by this paper to Deposit Account No. 15-0450.

Date: October 13, 2009

/David J. Muzilla/
Signature of Practitioner

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Attached hereto is:

"STATEMENT OF THE FACTS INVOLVED IN DETERMINING THE PATENT TERM ADJUSTMENT" 37 C.F.R. § 1.705(b)(2).

"ON APPLICATION FOR PATENT TERM ADJUSTMENT" Mailed August 31, 2009 by the Office of Petitions.

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**STATEMENT OF THE FACTS INVOLVED IN DETERMINING
THE PATENT TERM ADJUSTMENT
37 C.F.R. § 1.705(b)(2)**

1. This statement is being submitted in support of the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT 37 C.F.R. § 1.705(d)" to which this statement is attached.

The patent term adjustment shown on the first page of the issued patent is three hundred fifty five (355) days.

A five hundred twenty eight (528) day delay was charged against the USPTO and a one hundred seventy three (173) day delay was charged against the Applicant.

Applicant asserts that it is not correct to charge 528 days against the USPTO, and that instead, Applicant asserts that seven hundred thirty seven (737) days should be charged against the USPTO.

Applicant agrees that it is correct to charge 173 days against the Applicant.

Applicant respectfully suggests that the correct patent term adjustment under § 1.702(a) and § 1.702(b) is five hundred sixty four (564) days.

It is respectfully suggested that the correct patent number of days charged against the USPTO under 37 C.F.R. §§ 1.702(a) and 1.702(b) is seven hundred thirty seven (737) days. 37 C.F.R. § 1.702(a)(1) states that the term shall be adjusted if the Office fails to “[m]ail at least one of a notification under 35 U.S.C. 132... not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a)...” 37 C.F.R. § 1.702(b) states that the term shall be adjusted if the Office fails to

issue a patent within three years of the actual filing date of the application. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application, but not including: (1) Any time consumed by continued examination of the application under 35 U.S.C. 132(b); (2) Any time consumed by an interference proceeding under 35 U.S.C. 135(a); (3) Any time consumed by the imposition of a secrecy order under 35 U.S.C. 181; (4) Any time consumed by review by the Board of Patent Appeals and Interferences or a Federal court; or (5) Any delay in the processing of the application by the Office that was requested by the Applicant.

Basis, including relevant dates as specified in 37 C.F.R. § 1.703(a)(1):

The filing date was September 29, 2003 under 35 U.S.C. 111(a), and the ending date of a mailing of an action under 35 U.S.C. 132 was May 11, 2006. Based on these dates, the number of days between them is five hundred twenty eight (528) days.

Basis, including relevant dates as specified in 37 C.F.R. § 1.703(b):

The date, which begins three years after the filing, was September 29, 2006, and the ending date was April 26, 2007 because the adjusted term does not include days “consumed by continued examination of the application,” according to 37 C.F.R. § 1.703(b)(1). Therefore, based on these dates, the period of adjustment under 37 C.F.R. § 1.702(b) should be two hundred nine (209) days.

Furthermore, the correct days charged against the USPTO should be the summation of the days specified in 37 C.F.R. § 1.703(a) and 37 C.F.R. § 1.703(b). The USPTO may view these days as “overlapping” under 35 U.S.C. § 154(b)(2)(A), however, according to *Wyeth v. Dudas*, 2008 U.S. Dist. LEXIS 76063, the Court concluded that “the only way that periods of time can “overlap” is if they occur on the same day. If an “A delay” occurs on one calendar day and a “B delay” occurs on another, they do not overlap, and § 154(b)(2)(A) does not limit the extension to one day.” The Court reasoned that

[t]he problem with the PTO's construction is that it considers the application *delayed* under § 154(b)(1)(B) during the period *before it has been delayed*. That construction cannot be squared with the language of § 154(b)(1)(B), which applies "if the issue of an original patent is *delayed* due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years." (Emphasis added.) "B delay" begins when the PTO has failed to issue a patent within three years, not before.

In this instance, the days calculated under 37 C.F.R §§ 1.702(a) and 1.702(b) overlap by zero (0) days, and it is Applicant's position that the correct number of days charged against the USPTO is 737 days.

3. 37 C.F.R. § 1.705(b)(2)(ii) and (iv)

The Applicant respectfully agrees with the USPTO that the Reduction of Period of Adjustment of Patent Term under § 1.704 is one hundred seventy three (173) days. Presently, 173 days are charged against the Applicant. 37 C.F.R § 1.704(b) states that

With respect to the grounds for adjustment set forth in §§ 1.702(a) through (e), and in particular the ground of adjustment set forth in § 1.702(b), an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph.

Basis, including relevant dates for an adjustment as specified in 37 C.F.R § 1.704(b):

First, after a mailing of a notice of incomplete application on December 22, 2003, the Applicant responded on May 24, 2004, which was sixty three (63) days after the three month period from the date the notice was mailed to the Applicant.

Second, after a mailing of a final rejection on November 2, 2006, the Applicant responded on April 26, 2007, which was eighty three (83) days after the three month period from the date the notice was mailed to the Applicant.

Third, after a mailing of a non-final rejection on November 5, 2008, the Applicant responded on March 4, 2009, which was twenty seven (27) days after the three month period from the date the notice was mailed to the Applicant.

Therefore, it is Applicant's position that the Reduction of Period of Adjustment of Patent Term under § 1.704 is 173 days.

4. 37 C.F.R. § 1.705(b)(2)(iii)

This patent is not subject to a terminal disclaimer.

Respectfully submitted,

Date: October 13, 2009

/David J. Muzilla/
Signature of Practitioner

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MAILED
AUG 31 2009
OFFICE OF PETITIONS

In re Application of :
De Voir, et al. :
Application No. 10/674,270 : ON APPLICATION FOR
Filed: September 29, 2003 : PATENT TERM ADJUSTMENT
Atty Docket No. 117163.00092 :

This is in response to the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b), filed June 19, 2009. Applicants submit that the correct patent term adjustment to be indicated on the patent is five hundred sixty-four (564) days, not three hundred fifty-five (355) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicants request this correction solely on the basis that the Office will take in excess of three years to issue this patent.

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentees are entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). This is true even in this instance where a request for continued examination (RCE) was filed. The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment the filing date of the request for continued examination is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicants must timely file an application for patent term adjustment prior to the payment of the issue fee¹.

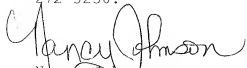
The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

¹ For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Shirene Willis Brantley at (571) 272-3230.

A handwritten signature in black ink, appearing to read "Nancy Johnson". The signature is fluid and cursive, with the first name "Nancy" being more prominent than the last name "Johnson".

Nancy Johnson
Senior Petitions Attorney
Office of Petitions